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REMARKS

The Double Patenting Rejection

Claims 38-52 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 15-34 of copending application number 09/280,020. This rejection is traversed.

To sustain this rejection, the Patent Office must meet its burden under a one-way determination of obviousness. In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998) That is, the Patent Office would need to prove that the methods recited in present claims 38-52 are obvious variations of the methods defined in claims 15-34 of copending application number 09/280,020. Subcutaneous administration, the route of administration set forth in present claims 38-52, however, would not have been obvious in view of oral or nasal administration, the routes of administration set forth in claims 15-34 of copending application number 09/280,020. Notably, for example, subcutaneous administration is technically distinct and is invasive, while oral and nasal administration is not.

The Manual of Patent Examining Procedure §804.02, citing Quad Environmental Technologies Corp. v. Union Sanitary District, F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991), states that the “filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection.” Given that fact, and the fact that the term of any patent issuing from the subject application or that having application number 09/280,020 would be the same, a terminal disclaimer is being filed herewith merely in order to expedite prosecution. Hence, this rejection is rendered moot, and withdrawal of the rejection is proper and hereby requested.

The 35 U.S.C. §112, First Paragraph, Rejection

Claims 50-52 stand rejected under 35 U.S.C. §112, First Paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

In the Final Office Action, the Patent Office referred to the recited phrase “glucagon-like peptide 1 related peptide” in proposing a rejection for alleged lack of written description support. During the telephonic interview with Applicant’s Representatives on May 21, 2002, however, reference was made to the fact that the phrase “glucagon-like peptide 1-related peptide” is literally set forth in the originally

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filed specification (for example, see page 4, lines 26-30; also see page 8, lines 9-11), and the fact that the Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, ¶1, "Written Description" Requirement, published in the Federal Register on January 5, 2001, state: "There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed."¹ The Examiner agreed to withdraw this rejection.

Information Disclosure Statement

Finally, Applicant wishes to again bring the Examiner's attention to the fact that an initialed copy of the Form PTO-1449 submitted with the Information Disclosure Statement on August 18, 1999, has not been returned to Applicant. Applicant requests that such a copy be provided with the mailing of the next Communication from the Patent Office.

Respectfully Submitted,

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¹ See Section II.A. thereof.